

See Paper  
No. 9

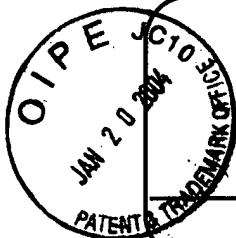
2134

PTO/SB/21 (08-03) (AW 10/2003)

Approved for use through 7/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.



## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission **13**

Application Number 10/066,901

Filing Date February 4, 2002

First Named Inventor Yoshiho Gotoh, et al

Art Unit 2134

Examiner Name Paul E. Callahan

Attorney Docket No. MTS-710US26

**RECEIVED**

**JAN 21 2004**

Technology Center 2100

### ENCLOSURES (Check all that apply)

- ☐ Fee Transmittal Form
  - ☐ Fee Attached
- ☐ Amendment/Reply
  - ☐ After Final
  - ☐ Affidavits/Declaration(s)

- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/  
Incomplete Application
  - ☐ Response to Missing Parts under  
37 CFR 1.52 or 1.53

- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☒ Petition
- ☐ Petition to Convert to a  
Provisional Application
- ☐ Power of Attorney, Revocation,  
Change of Correspondence  
Address
- ☐ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s) \_\_\_\_\_

- ☐ After Allowance Communication  
to Group
- ☐ Appeal Communication to Board  
of Appeals and Interferences
- ☐ Appeal Communication to Group  
(Appeal Notice, Brief, Reply  
Brief)
- ☐ Proprietary Information
- ☐ Status Letter
- ☒ Other Enclosure(s) (please  
identify below):  
Return Postcard

Remarks:

### SIGNATURE OF APPLICANT, ATTORNEY OR AGENT

Firm or  
Individual

Lawrence E. Ashery

Registration No. (Attorney/Agent)

34,515

Signature

Date

January 15, 2004

### CERTIFICATE OF TRANSMISSION / MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this date:

January 15, 2004

Name (Print/Type)

Lawrence E. Ashery

Signature

Date

January 15, 2004

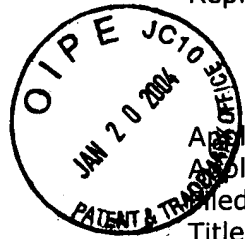
This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 422 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, ALEXANDRIA, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Appln. No.: 10/066,901

MTS-710US26

Reply to Office Communication Dated: January 12, 2004



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appln. No: 10/066,901  
Applicant: Y. Gotoh et al.  
Filed: February 4, 2002  
Title: OPTICAL DISK, AN OPTICAL DISK BARCODE FORMING METHOD, AN OPTICAL DISK REPRODUCTION APPARATUS, A MARKING FORMING APPARATUS, A METHOD OF FORMING A LASER MARKING ON AN OPTICAL DISK, AND A METHOD OF MANUFACTURING AN OPTICAL DISK  
TC/A.U.: 2134  
Examiner: Paul E. Callahan  
Confirmation No.: 5932  
Docket No.: MTS-710US26

**PETITION UNDER 37 CFR 1.181 TO RESCIND ABANDONMENT**

Attention: Office of Petitions  
Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RECEIVED**  
JAN 21 2004  
Technology Center 2100

Sir:

A Notice of Abandonment dated January 12, 2004 (copy enclosed) was issued in error by the United States Patent and Trademark Office. This Petition is being filed to rescind the abandonment, return this application to pending status, and resume prosecution. The relevant facts are as follows:

(1) On September 22, 2003 an Amendment (copy enclosed) was filed with the United States Patent and Trademark Office in response to the June 20, 2003 Office Action as evidenced by the enclosed copy of the postcard date-stamped by the United States Patent and Trademark Office.

(2) On December 18, 2004, Applicants' Attorney's office called Examiner Paul Callahan to inquire as to the status of the September 22, 2003 Amendment. Examiner Callahan agreed to check into the status of the Amendment and report his findings to Applicants' Attorney's office.

(3) On December 19, 2004, Examiner Callahan called Applicants' Attorney's office and stated that he could find no record of the September 22, 2003 Amendment being entered

Reply to Office Communication Dated: January 12, 2004

into the Patent Application Information Retrieval system of the United States Patent and Trademark Office.

(4) On January 8, 2004, Applicants' Attorney's office faxed a copy of the Amendment and accompanying papers filed on September 22, 2003 to the United States Patent and Trademark Office Centralized Fax location, as required by the December 1, 2003 Centralized Delivery and Facsimile Transmission Requirements For Patent Application Related Correspondence, indicating on the facsimile cover sheet "Amendment As Previously Filed." A copy of the facsimile confirmation cover sheet showing successful transmission of the facsimile is enclosed.

For the reasons set forth above, it is respectfully requested that the Notice of Abandonment be withdrawn and the Amendment filed on September 22, 2003 be entered.

Respectfully submitted,

RatnerPrestia

Lawrence E. Ashery, Reg. No. 34,515  
Attorney for Applicants

LEA/ds

Enclosures: Notice of Abandonment  
Amendment dated September 22, 2003  
Date Stamped Postcard  
Copy of January 8, 2004 Facsimile Confirmation Cover Sheet

Dated: January 15, 2004

P.O. Box 980  
Valley Forge, PA 19482

The Commissioner for Patents is hereby authorized to charge payment to Deposit Account No. **18-0350** of any fees associated with this communication.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

January 15, 2004

2 msc

MTS-710US26



UNITED STATES PATENT AND TRADEMARK OFFICE

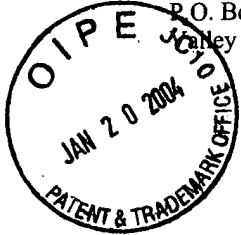
COPY

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,901	02/04/2002	Yoshiho Gotoh	MTS-710US26	5932

7590 01/12/2004

Ratner & Prestia  
500 North Gulph Road  
P.O. Box 980  
Valley Forge, PA 19482



JAN 14 2004

EXAMINER

CALLAHAN, PAUL E

ART UNIT PAPER NUMBER

2137

DATE MAILED: 01/12/2004

8

PETITION TO REINVE (imp)  
2/12/04 / JED

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED

JAN 21 2004

Technology Center 2100

SK



# Notice of Abandonment

Application No.

10/066,901

Examiner

Paul E. Callahan

Applicant(s)

GOTOH ET AL.

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 20 June 2003.
  - (a) ☐ A reply was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
  - (b) ☐ A proposed reply was received on \_\_\_\_\_, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.  
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
  - (c) ☐ A reply was received on \_\_\_\_\_ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
  - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
  - (a) ☐ The issue fee and publication fee, if applicable, was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
  - (b) ☐ The submitted fee of \$\_\_\_\_\_ is insufficient. A balance of \$\_\_\_\_\_ is due.  
The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_. The publication fee, if required by 37 CFR 1.18(d), is \$\_\_\_\_\_.
  - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
  - (a) ☐ Proposed corrected drawings were received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply.
  - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:

RECEIVED

JAN 21 2004

Technology Center 2100

*Paul Callahan*  
Paul Callahan  
1/8/04

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

# MEMORY TRANSMISSION REPORT

PAGE : 001  
TIME : 01-08-2004 03:34PM  
TEL NUMBER: 610 407 0701  
NAME : RatnerPrestia

FILE NUMBER : 982  
DATE : 01-08 03:28PM  
TO : 17038729306  
DOCUMENT PAGES : 007  
START TIME : 01-08 03:28PM  
END TIME : 01-08 03:33PM  
SENT PAGES : 007  
STATUS : OK  
FILE NUMBER : 982

\*\*\* SUCCESSFUL TX NOTICE \*\*\*



**RatnerPrestia**  
WE SPECIALIZE IN THE LAW OF CREATIVITY

☒  
Suite 301, One Westlakes, Berwyn  
P.O. Box 980  
Valley Forge, PA 19482-0980  
Phone: 610-407-0700  
Fax: 610-407-0701

☐  
Nemours Building  
1007 Orange Street, Suite 1100  
P.O. Box 1596  
Wilmington, DE 19899  
Phone: 302-778-2500  
Fax: 302-778-2600  
www.ratnerprestia.com

☐  
Suite 265  
Commerce Corporate Center  
5100 Tilghman Street  
Allentown, PA 18104  
Phone: 610-530-8100  
Fax: 610-530-8200

## FACSIMILE COVER SHEET

DATE: January 8, 2004  
TIME:

OUR REF.: MTS-710 US26  
YOUR REF.: 10/066,901

TO:	CENTRALIZED FAX
COMPANY:	United States Patent and Trademark Office
FROM:	Lawrence E. Ashery
FAX TELEPHONE:	(703) 872-9306
OFFICE TELEPHONE:	
TITLE OF DOCUMENT:	Amendment

Total Number of Pages: 7 (Including this form)

### COMMENTS

AMENDMENT AS PREVIOUSLY FILED

### CONFIDENTIAL AND PRIVILEGED ATTORNEY/CLIENT INFORMATION

This facsimile transmission (and/or documents accompanying it) may contain attorney/client privileged communications and confidential business information that is intended for use only by the individual or company to whom it is addressed. Disclosure, interception, copying or any other use of this transmission by anyone other than any intended recipient is prohibited. If you receive this transmission by mistake, please notify the sender.

Please notify us immediately if you have not received the number of pages indicated above.



# RatnerPrestia

WE SPECIALIZE IN THE LAW OF CREATIVITY®



Suite 301, One Westlakes, Berwyn  
P.O. Box 980  
Valley Forge, PA 19482-0980  
Phone: 610-407-0700  
Fax: 610-407-0701



Nemours Building  
1007 Orange Street, Suite 1100  
P.O. Box 1596  
Wilmington, DE 19899  
Phone: 302-778-2500  
Fax: 302-778-2600



Suite 265  
Commerce Corporate Center  
5100 Tilghman Street  
Allentown, PA 18104  
Phone: 610-530-8100  
Fax: 610-530-8200

[www.ratnerprestia.com](http://www.ratnerprestia.com)

## FACSIMILE COVER SHEET

DATE: January 8, 2004 OUR REF.: MTS-710 US26  
TIME: \_\_\_\_\_ YOUR REF.: 10/066,901

TO:	CENTRALIZED FAX
COMPANY:	United States Patent and Trademark Office
FROM:	Lawrence E. Ashery
FAX TELEPHONE:	(703) 872-9306
OFFICE TELEPHONE:	
TITLE OF DOCUMENT:	Amendment

Total Number of Pages: 7 (including this form)

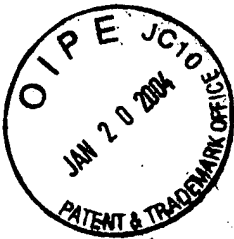
### COMMENTS

AMENDMENT AS PREVIOUSLY FILED

### CONFIDENTIAL AND PRIVILEGED ATTORNEY/CLIENT INFORMATION

This facsimile transmission (and/or documents accompanying it) may contain attorney/client privileged communications and confidential business information that is intended for use only by the individual or company to whom it is addressed. Disclosure, interception, copying or any other use of this transmission by anyone other than any intended recipient is prohibited. If you receive this transmission by mistake, please notify the sender.

**Please notify us immediately if you have not received the number of pages indicated above.**



Date: SEPT 22 2003

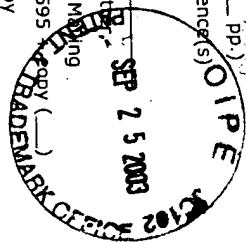
Commissioner for Patents:  
Please acknowledge receipt of the document(s) described below by imprinting the Patents & Trademark Office "date-stamp" hereon and returning this card to the addressee on the reverse side.

FILE NO.: 710 0536 MTS 1 FEE DUE? YES or NO AMT. ENCD. \$       

NAME: V. Gatch et al.

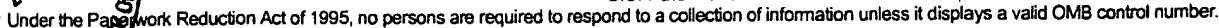
- |   |  |
|---|--|
| <input type="checkbox"/> Specification (_____ pp.)          | <input type="checkbox"/> Drawing(s) (_____ pp.)            |
| <input type="checkbox"/> IDS & PTO 1449 (_____ pp.)         | <input type="checkbox"/> Copy of _____ Reference(s)        |
| <input type="checkbox"/> Copy of Search Report              | <input type="checkbox"/> Form 1390 + copy                  |
| <input type="checkbox"/> Claim to Right of Priority         | <input type="checkbox"/> Priority Document(s)              |
| <input type="checkbox"/> Response to Missing Parts          | <input type="checkbox"/> Copy of Formalities Letter        |
| <input type="checkbox"/> Declaration & POA (_____ pp.)      | <input type="checkbox"/> Certificate of Express Mailing    |
| <input type="checkbox"/> Petition for Ext. of Time          | <input type="checkbox"/> Assignment & Form 1595            |
| <input type="checkbox"/> Utility Transmittal                | <input type="checkbox"/> Fee Transmittal + copy            |
| <input type="checkbox"/> Amendment/Response ( <u>4</u> pp.) | <input type="checkbox"/> Preliminary Amendment (_____ pp.) |
| <input type="checkbox"/> Issue Fee/Publication Fee          | <input checked="" type="checkbox"/> Transmittal Form       |

Serial No.: 19/066,901



**RECEIVED**  
JAN 21 2004  
Technology Center 2100





Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

*(to be used for all correspondence after initial filing)*

Total Number of Pages in This Submission 5

Attorney Docket No.	MTS-710US26
---------------------	-------------

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

Appln. No.: 10/066,901  
Amendment Dated September 22, 2003  
Reply to Office Action of June 20, 2003



MTS-710US26

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appln. No: 10/066,901  
Applicant: Y. Gotoh et al.  
Filed: February 4, 2002  
Title: OPTICAL DISK, AN OPTICAL DISK BARCODE FORMING METHOD, AN  
OPTICAL DISK REPRODUCTION APPARATUS, A MARKING FORMING  
APPARATUS, A METHOD OF FORMING A LASER MARKING ON AN OPTICAL  
DISK, AND A METHOD OF MANUFACTURING AN OPTICAL DISK  
TC/A.U.: 2134  
Examiner: Paul E. Callahan  
Confirmation No.: 5932  
Docket No.: MTS-710US26

**AMENDMENT**

Mail Stop Non-Fee Amendmet  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RECEIVED**

JAN 21 2004

Technology Center 2100

Sir:

Responsive to the Office Action dated June 20, 2003, please amend the above-identified application as follows:

- ☐ **Amendments to the Specification** begin on page \_\_\_\_\_ of this paper.
- ☒ **Amendments to the Claims** are reflected in the listing of claims which begins on page **2** of this paper.
- ☐ **Amendments to the Drawings** begin on page \_\_\_\_\_ of this paper and include an attached replacement sheet(s).
- ☐ **Amendments to the Abstract** are on page \_\_\_\_\_ of this paper. A clean version of the Abstract is on page \_\_\_\_\_ of this paper.
- ☒ **Remarks/Arguments** begin on page **3** of this paper.

**Amendments to the Claims:** This listing of claims will replace all prior versions, and listings, of claims in the application

Listing of Claims:

Claims 1-35 (canceled)

36. (Currently Amended) An optical disk, comprising:

an information recording area;

a barcode-like mark;

an identifier for indicating whether or not said barcode-like mark is present on said optical disk, ~~and~~

said barcode-like mark including a plurality of bars, each of said bars extending in a radial direction, and

wherein said identifier is provided in the information recording area.

37. (Previously Presented) An optical disk according to claim 36, wherein

an identifier which indicates whether the barcode-like marks are present or not, is provided in the control data area of information recording area.

38. (New) An optical disk, comprising:

a barcode-like mark;

an identifier on said optical disk and separate from said barcode-like mark for indicating whether or not said barcode-like mark is present on said optical disk, and

said barcode-like mark including a plurality of bars, each of said bars extending in a radial direction.

**Remarks/Arguments:**

Claims 36 and 37 have been rejected under obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,052,465. Furthermore, claims 36 and 37 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,706,047 (Lentz et al.) in view of U.S. Patent No. 3,752,961 (Torrey) and Official Notice. It is respectfully submitted, however, that these claims are patentable over the art of records for the reasons set forth below.

Applicants' invention, as recited by claim 36, includes a feature which is neither disclosed nor suggested by the art of record, namely:

. . .an information recording area. . .

an identifier for indicating whether or not said barcode-like mark is present on said optical disk. . .

said identifier is provided in the information recording area

This feature is supported by the originally filed application at page 3, lines 1 -5. No new matter has been added.

This feature is not recited in claims 1 and 2 of U.S. Patent No. 6,052,465. Therefore, withdrawal of the obviousness-type double patenting rejection is respectfully requested.

In addition, neither Lentz nor Torrey disclose this feature. The Official Action acknowledges that "Lentz does not teach inclusion of an identifier." Furthermore, the Official Action acknowledges that "Torrey does not teach the use of an identifier." Thus, even by combining Lentz and Torrey, Applicants' claim 36 does not result. While the Official Action takes official notice "that the use of a control data area of a disk to write identifiers is a step that is old and well known in the art," no reference has been placed on the record which discloses the feature of an identifier which indicates presence or absence of a barcode. As this feature is neither disclosed nor suggested by the art of record, claim 36 is patentable over the art of record.

Claim 37 is also patentable by virtue of its dependency on allowable claim 36.

Appln. No.: 10/066,901  
Amendment Dated September 22, 2003  
Reply to Office Action of June 20, 2003

MTS-710US26

Applicants have added new claim 38. Claim 38 recites the feature of:

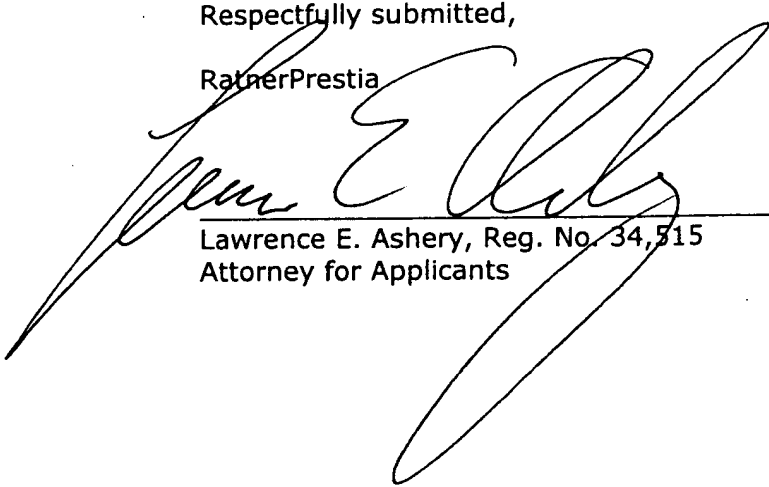
...an identifier on said optical disk and separate from said barcode-like mark for indicating whether or not said barcode-like mark is present on said optical disk

Again, this feature is neither disclosed nor suggested by the art of record. Accordingly, claim 38 is patentable over the art of record.

For the reasons set forth above, the above-identified application is in condition for allowance which action is respectfully requested.

Respectfully submitted,

RatnerPrestia



Lawrence E. Ashery, Reg. No. 34,515  
Attorney for Applicants

LEA/kc

Dated: September 22, 2003

P.O. Box 980  
Valley Forge, PA 19482  
(610) 407-0700

The Commissioner for Patents is hereby authorized to charge payment to Deposit Account No. **18-0350** of any fees associated with this communication.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:



September 22, 2003

K\_I:\MTS\710US26\AMEND01.DOC